

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

HYUN-SOOK KIM et al.

Serial No.: 09/918,552

Examiner: PERRIN, J.

Filed: 1 August 2001

Art Unit: 1746

For: WASHING MACHINE AND CONTROLLING METHOD THEREOF

PETITION UNDER 37 CFR §1.181(a)(1)

Mail Stop : PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petition to withdraw the Examiner's objection to claims 4, 5 and 26-28 in the final Office action (Paper No. 6) mailed on 17 November 2003, and to provide a non-final Office action on the merits with respect to claims 4, 5 and 26-28.

Applicants believe that no fee is incurred by the filing this Petition however, should the other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Folio: P56564
Date: 1/16/2004
I.D.: REB/JHP/rfc

STATEMENT OF FACTS

1. In the first Office action (Paper No. 3) mailed 2 July 2003, the claims 4 and 5 were objected to under 37 CFR 1.75(c) as being improper dependent form for failing to further limit the subject matter of a previous claim.
2. In response the first office action (Paper No.3) Applicant filed Reply on 30 September 30, 2003 traversing the examiner's objection and requesting a reconsideration of the objection. In the Reply filed on 30 September 2003, claims 24-34 were newly added and claims 1-4 and 6-16 were amended.
3. On 17 November 2003 the Examiner mailed a "final" Office action (Paper No. 6). In the final Office action (Paper No. 6), the objection of claims 4-5 has been maintained for reasons of record and the examiner further objected to claims 26-28. The examiner stated that the claims 4-5 and 26-28 have not been further treated on the merits.

ARGUMENTS AND/OR REMARKS

The examiner asserted in the final Office action that “Claims 4-5 & 26-28 are objected to under 37 CFR 1.75(c) as being improper dependent form for failing to further limit the subject matter of a previous claim” on the basis of that “the claims are directed to intended use (e.g. how the heating part is controlled and what washing cycles are selected, respectively).”

The examiner’s objection is not proper for the following reasons.

First, the claims 4-5 and 26-28 are not directed to “intended use.”

The examiner explained “intended use” by citing *Ex parte Masham* on page 4 of the final Office action and asserted that “it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.” *Ex parte Masham*, 2 USPQ2d 1647.

In *Ex parte Masham*, the claim 1 reads as follows: “1. An apparatus for mixing flowing developer material, including....” In *Ex parte Masham*, the issue was whether the intended use of the invention in the preamble differentiates the claimed apparatus from a prior art apparatus.

It is hardly understood why the features of the elements recited in claims 4-5 and 26-28 are regarded as the intended use of the invention. The “intended use” means a purpose of the invention, or the utility of the invention. In the present application, it is clear that the intended use of the washing machine is washing an article and is described as “washing machine” in the preamble. The examiner improperly regarded the feature of the invention as an intended use. The examiner is confused between the intended use of the invention and the features of the element.

The examiner’s reasoning on the basis of the “intended use” is not proper.

Second, the features recited in claims 4, 5 and 26-28 further limit the subject matter of the parent claim.

If a feature recited in a dependent claim is necessarily present in the parent claim, the dependent claim reciting only the feature may be improper. (For example, where Claim 1 recites “A desk comprising four legs and a plate mounted on said four legs,” and Claim 2 recites “The desk of claim 1, wherein said four legs support the plate,” claim 2 may be improper because claim 2 merely recites the function necessarily performed by claim 1.) Here, however, the features recited in claims 4-5 and 26-28 are not necessarily present in their parent invention. For example, the controller may control (1) the heater independently of the inputted washing course or (2) the circulating pump and the heater in accordance with the inputted washing course as claimed in claim 4. That is, the feature of claim 4 is not necessarily present in claim 3. Regarding claim 5 of the present application, the “washing course” to be inputted into the washing machine may include “a boiling course” or may not include “a boiling course.” Likewise, the features recited in claims 26-28 are not necessarily present in their parent claims. Also, it is clear to the ordinary skilled person in the art that the recitation of the features in claims 4, 5 and 26-28 result in different structural elements. Therefore, since claims 4-5 and 26-28 further limit the subject matter of the parent claim, the dependent claims 4-5 and 26-28 are proper.

Third, the law permits the applicant to define an element by what it does.

MPEP 2173.05(g) states that:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

The law clearly permits the applicant to define an element by what it does.

The examiner argued that

“A careful reading of *Swinehart* will reveal that the indicated case is distinguishable from the current situation. In *Swinehart* the court held that the recitation of “transparent to infrared rays,” while language was functional, it was precise and definite enough to provide clear-cut indication of scope of subject matter. This however is not the case in the present situation. In the instant case, applicant is attempting to claim the operation of the claimed apparatus in dependent claim form, which is entirely different than claiming function in place of structure as in *Swinehart*.” (Page 5, lines 7-15 in the final Office action.)

It is hardly understood what the examiner’s reasoning is. The examiner did not argue that the claims 4-5 and 26-28 were not precise and definite enough to provide clear-cut indication of scope of subject matter. In view of this fact, it looks like that the examiner improperly argued that the functional language only cannot be used in the dependent claims because the functional language itself is not given any patentable weight, and thus in the present case the dependent claims 4-5 and 26-28 failed to further limit the subject matter of the parent claims. If the applicant’s understanding of the examiner’s reasoning is correct, the examiner’s reasoning is still not proper. In *In re Swinehart*, the court held that “it is elementary that the mere recitation of a newly discovered function or property, *inherently possessed* by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.” 169 USPQ 226, 229 (CCPA 1971). That is, in *In re Swinehart*, while the court held that the function inherently possessed by the prior art did not cause the claim to distinguish over the prior art, the court did not hold that the applicant cannot define an element by what it does or that every functional language should not be given any patentable weight. The examiner must consider whether the languages in claims

4-5 and 26-28 are a mere recitation of the function inherently possessed by the parent claim to determine whether the features are not given any patentable weight. As stated above, since the features of claims 4-5 and 26-28 are not inherently possessed by the parent claim, claims 4-5 and 26-28 properly further limit the subject matter of their parent claims.

Finally, the dependent claims 4-5 and 26-28 include every limitation of the parent claim.

MPEP §608.01(n) states that “Claims which are in improper dependent form for failing to further limit the subject matter of a previous claim should be objected to under 37 CFR 1.75(c) by using form paragraph 7.36. Here, the examiner properly used form paragraph 7.36 for objecting to the dependent claims 4-5 and 26-28.

It should be noted that MPEP §608.01(n), PTO form paragraph 7.36 Examiner Note 2 clearly says that:

“The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim.”

It is clear from form paragraph 7.36 Examiner Note 2 that the test for the examiner’s objection in this case is whether the dependent claims 4, 5 and 26-28 include every limitation of their parent claims. Nonetheless, the examiner disregarded the test cited in the Examiner Note of form paragraph 7.36. (Instead, the examiner improperly applied the test of whether the claims differ in scope and incorrectly concluded that the claims 4-5 and 26-28 do not differ in scope.) Here, the examiner did not argue that the

dependent claims 4-5 and 26-28 fail to include every limitation of the parent claim. (It is clear that the dependent claims 4-5 and 26-28 include every limitation of the parent claim.)

Since claims 4-5 and 26-28 meet the test for PTO form paragraph 7.36, the dependent claims 4-5 and 26-28 are proper.

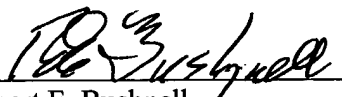
Therefore, for at least one of the above reasons, the examiner's objection is improper.

REMEDY REQUESTED

The Commissioner is respectfully requested to:

1. Withdraw the Objections of claims 4-5 and 26-28;
2. Provide a non-final Office action on the merits with respect to claims 4, 5 & 26-28; and
3. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,



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